

REMARKS

By this Amendment, claims 333 and 335 have been amended to correct minor informalities. Since the minor informalities were readily apparent, the corrections do not narrow the claim scope.

Claims 1-335 are pending in the application, of which claims 1, 24, 26, 27, 28, 84, 127, 170, 201, 233, 264, 332, 333, 334, and 335 are independent. Claims 1-83, 296-301, 308-313, and 320-325 have been allowed.

For the following reasons, Applicant respectfully requests reconsideration of this application and withdrawal of the objection and rejections outstanding in the August 18, 2006, Office Action.

As an initial matter, Applicant respectfully notes that the Office Action did not address claims 332-335, which were submitted in the Preliminary Amendment filed on August 10, 2001. These claims read on the elected species and therefore should have been examined. Accordingly, Applicant respectfully requests that the Office consider the August 10, 2001, Preliminary Amendment and examine claims 332-335. If the Office intends to reject any of those claims in any subsequent Office Action, Applicant respectfully requests that the Office set forth a detailed explanation of the basis for any such rejection and make that Office Action non-final to provide Applicant with a full and fair opportunity to respond.

Applicant also notes that the Office has withdrawn claims 85-87, 90-124, 128-130, 133-167, 171-198, 204-230, 234-261, 267-293, 302-307, 314-319, and 326-331 from consideration, as allegedly being directed to non-elected species. (Office Action at 2.) Applicant respectfully submits, however, that the withdrawal of at least claims 85-87, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-124, 128-130, 134-140, 142-146, 148-

150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331 is improper, because these claims either read on the elected species or were not subject to any of the species-election requirements applied in the Office Action dated March 22, 2006.

More specifically, in the Office Action dated March 22, 2006, the Office applied the following six species-election requirements:

1	<u>1A:</u> a wherein the "another" notch is the "second" notch (claims 89, 132, 203, and 266); and <u>1B:</u> a wherein the "another" notch is not the "second" notch (claims 90, 133, 204, and 267).
2	<u>2A:</u> a wherein the faces of the notch extend from one end of the brush to the other (original claim 4); and <u>2B:</u> a where the faces of the notch extend along only a part of a length of the brush (claims 98, 141, 177, 210, and 240).
3	<u>3A:</u> a wherein the notch back is convex (original claim 19); and <u>3B:</u> a where the notch back is planar (claims 104, 147, 182, 215, 245, and 278).
4	<u>4A:</u> a directed to the brush shape shown in Figs. 1A, 2, and 3 (original claim 10); <u>4B:</u> a directed to the brush shape shown in Fig. 6; <u>4C:</u> a directed to the brush shape shown in Fig. 7; <u>4D:</u> a directed to the brush shape shown in Fig. 8; <u>4E:</u> a directed to the brush shape shown in Fig. 9; and <u>4F:</u> a directed to the brush shape shown in Fig. 10.
5	<u>5A:</u> a wherein the trough line is straight (original claim 15); and <u>5B:</u> a wherein the trough line is curved (claims 115, 158, 191, 224, 254, and 287).
6	<u>6A:</u> a wherein the peak ridge is straight (original claim 18); and <u>6B:</u> a where the peak ridge is curved (claims 118, 119, 161, 162, 193, 226, 256, and 289).

In response to species-election requirement 1, Applicant elected Species 1A for prosecution in this application. (See Response to Election of Species Requirement dated April 24, 2006.) For the other five species-election requirements, however, the Office had asserted that Applicant constructively elected Species 2A, Species 3A, Species 4A, Species 5A, and Species 6A for prosecution in this application. These elections should have resulted in withdrawal of only claims 90, 98, 104, 108, 115, 118, 119, 133, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 204, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 267, 278, 282, 287, 289, and 314-319. All of the other claims (including those claims that were not subject to any of the species-election requirements) should have remained in the application for examination. Thus, Applicant respectfully requests reinstatement and examination of each of the improperly withdrawn claims identified above.

Objection to Drawings

In the Office Action, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a), asserting that “the back face of the at least one notch [being] defined by bristles having varying lengths,” as recited in claims 84 and 127, must be shown in the drawings. (Office Action at 2.) Applicant respectfully traverses this objection because the recited feature is clearly shown in the drawings:

For example, Figs. 1A, 2, 3, 7, and 10 illustrate various embodiments where the bristles defining the back face have varying lengths along an axis of the brush. As described in the specification (e.g., col. 4, lines 6-9), in the exemplary embodiment of Fig. 1A, the surface of the brush (which includes the back faces) has generatrices converging to a fixed point P, such that the lengths of the bristles that define the back

faces vary along the axis of the brush. Also, Figs. 1A, 1B, 2-5, 7, 8, 10, and 11 show that the lengths of the bristles that define the back face of a notch vary along a circumferential direction about the axis of the brush. The specification thus discloses "the back face of the at least one notch [being] defined by bristles having varying lengths," as recited in claims 84 and 127.

For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the objection to the drawings.

35 U.S.C. § 112, First Paragraph, Rejection

The Examiner rejected claims 84 and 127 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts that "the back face of the at least one notch [being] defined by bristles having varying lengths," as recited in claims 84 and 127, was not described in the specification and, therefore, constitutes new matter. (Office Action at 3.) Applicant respectfully traverses this rejection.

As explained above, the originally filed drawings clearly show the recited feature. Under the law of written description, an applicant may show possession of the claimed invention by describing it using, inter alia, such descriptive means as structures, figures, and diagrams that fully set forth the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997). See also M.P.E.P. § 2163. Since the original disclosure fully supports this feature of claims 84 and 127, they satisfy the written description requirements under 35 U.S.C. § 112, first paragraph. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 112, Second Paragraph, Rejection

The Examiner rejected claims 84, 88, 89, 125-127, 131, 132, 168, and 169 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. (Office Action at 4.) Specifically, the Examiner asserted that the recitation of “the back face of the at least one notch [being] defined by bristles having varying lengths” renders the claims indefinite, because the claimed subject matter allegedly has no support in the specification. Applicant respectfully traverses this rejection.

As explained above, the original disclosure, which includes the drawings, fully supports this claimed feature. Therefore, Applicant respectfully requests withdrawal of this rejection.

Moreover, 35 U.S.C. § 112, second paragraph, is not a proper basis for a rejection based on alleged lack of support. A claim term is not indefinite if the meaning of the claim term is discernible. See, e.g., Bancorp Services, L.L.C. v. Hartford Life Ins. Co., 359 F.3d 1367, 1372 (Fed. Cir. 2004) (holding that the disputed claim term, which was not used in the specification, was discernible and hence not indefinite because “the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence”). Since the Examiner’s rejection under § 112, second paragraph, appears to be based solely on the incorrect assertion that the claimed feature lacks written-description support, and not based on indefiniteness, this rejection should be withdrawn for this additional reason.

35 U.S.C. § 102(b) Rejection

The Examiner rejected claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 221-233, 262-266, 294, and 295 under 35 U.S.C. § 102(b), as being anticipated by U.S.

Patent No. 4,403,624 to Montgomery ("Montgomery"). Applicant respectfully traverses this rejection.

Montgomery discloses applicators for applying cosmetics, such as mascara, to the eye lashes. The Examiner's rejection relied on the embodiment shown in Figs. 11-13, which discloses an applicator that includes a handle portion 26, a rod 28 extending from the handle portion 26, and a brush portion located on an end of the handle portion 26. The brush portion includes teeth 66" affixed to the rod 28. As shown in Fig. 13, a portion of the teeth 66" extends radially around a bottom half of the rod 28, and the remaining portion of the teeth 66" extends vertically, parallel to one another, from a top half of the rod 28.

The Examiner asserted that the handle portion 26 and the teeth 66" of Montgomery correspond to the recited "elongated core" and "bristles," respectively. The Examiner also asserted that the claimed "at least one notch on the external surface of the brush" is "constitute[d] by the gap between the bristles as shown in Fig. 13." (Office Action at 5.)

As explained below, Montgomery does not disclose or otherwise suggest the subject matter of independent claims 84, 127, 170, 201, 233, 264, 332, 333, 334, and 335.¹

Each of independent claims 84, 127, 170, and 233 recites, among other things, "ends of said bristles defining an external surface of the brush" and "at least one notch on the external surface of the brush, the at least one notch comprising a front face and

¹ As explained above, the Office Action failed to address claims 332-335.

a back face, ... wherein the front and back faces ... intersect one another at a trough line." Similarly, each of independent claims 201, 264, 332, 333, 334, and 335 recites, among other things, "ends of said bristles defining an external surface of the brush," and "at least two notches on the external surface of the brush, the at least two notches each comprising a front face, a back face, and a trough line, ... wherein the front and back faces ... intersect one another at the trough line."

The Montgomery reference fails to teach or suggest each of these features. Although the Examiner asserts that the gap between the teeth 66" of Montgomery corresponds to the recited "notch," and that "the line that divides the [teeth 66]" as shown in Fig. 13" corresponds to the recited "trough line," Applicant respectfully disagrees with these assertions. As an initial matter, the "gap" between the teeth 66" of Montgomery, as identified by the Examiner, is not on an "external surface of the brush" (defined by ends of the bristles of the brush), as recited in the claims. Accordingly, the Examiner's "gap" in Montgomery does not correspond to the recited "notch."

Moreover, contrary to the Examiner's assertion, Montgomery fails to teach or suggest that the front and back faces of a notch "intersect one another at a trough line," as recited in each of the claims. While the Examiner has asserted that, in Montgomery, this feature is "constituted by the line that divides the bristles as shown in Fig. 13)" (Office Action at 6), the Examiner has failed to identify where Montgomery discloses any such "line that divides the bristles," or where Montgomery discloses that front and back faces of a notch "intersect one another" at a trough line, as recited in the claims. Applicant respectfully submits that Montgomery fails to teach or suggest these claimed features.

For at least these reasons, each of the independent claims, and their respective dependent claims, patentably distinguish from Montgomery. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Montgomery.

Conclusion

Applicant respectfully requests reconsideration of this application, withdrawal of all of the outstanding objection and rejections, and allowance of pending claims 1-335.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to necessarily subscribe automatically to any statement or characterization in that Office Action, regardless of whether it is addressed above.

In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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